

REMARKS/ARGUMENTS

This Amendment and the following remarks are intended to fully respond to the Office Action dated March 25, 2005. In that Office Action claims 33-64 were examined, and all claims were rejected. More specifically, claims 55-64 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter, specially a software program product; claims 33-62, and 64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Beaton et al. (U.S.P.N. 6,037,937), and Eftekhari (U.S. Publ. No. 2002/0024505); and claim 63 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Beaton et al., Eftekhari, and Hoeksma (U.S.P.N. 6,271,835). Reconsideration of these rejections, as they might apply to the original and amended claims in view of these remarks, is respectfully requested.

In this Response, claims 55-64 have been amended and no claims have been canceled.

Claim Rejections – 35 U.S.C. § 101

Claims 55-64 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter, specially a software program product. The preambles of claims 55-64 have been amended as suggested in the Office Action. Reconsideration of these claims in light of these amendments, and the below remarks, is respectfully requested.

Claim Rejections – 35 U.S.C. § 103

Claims 33-62, and 64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Beaton et al. (U.S.P.N. 6,037,937), and Eftekhari (U.S. Publ. No. 2002/0024505). Claim 63 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Beaton et al., Eftekhari, and Hoeksma (U.S.P.N. 6,271,835).

This is the first citation of the Eftekhari publication in this RCE application. It is noted that the Eftekhari publication has a filing date of January 19, 2001 -- only 12 days prior to the filing date of the present application (filed on January 31, 2001). Furthermore, while the Eftekhari publication appears to be a CIP application, the parent application has not been published and thus is not available for review by the Applicant. Thus, due to the relatively short

time period involved, Applicant has elected to swear behind this newly-cited reference. It is noted that the undersigned attorney telephoned the Examiner to discuss this matter, but no return call was received.

In the present case, the sole inventor, Mr. Eric Lang, signed the declaration for the patent application on January 12, 2001, a full week before the filing date of the Eftekhari publication. See Exhibit A to the Declaration of Ido Tuchman, attached hereto. Thus, it is apparent that the invention was fully “conceived” prior to the filing date of the Eftekhari publication. That is, the signed declaration from the inventor establishes conception of the entire invention disclosed and claimed in the present application. While 37 C.F.R. 1.131 requires corroboration of evidence showing conception, there can be no better evidence of proof of conception than the signed declaration of the inventor stating that he has reviewed the specification and claims, and that he declares he is the original, first and sole inventor of the subject matter claimed. Therefore, while it is obvious that the actual conception of the invention occurred prior to the date that the inventor’s declaration was signed, it is sufficient for the purposes of the present response to rely solely on the date of the signed declaration to establish prior conception, although Applicant clearly reserves the right to establish an earlier date of conception should the Examiner cite a new prior art reference.

Thus, pursuant to 37 C.F.R. 1.131, Applicant need only demonstrate a diligent effort to reduce the invention to practice from a time prior to the filing date of the Eftekhari publication (January 19, 2001) to the actual filing date of the present application (January 31, 2001). This diligence is shown by the efforts of the patent attorney charged with preparing and filing the patent application, as detailed in the attached Rule 131 Declaration of Ido Tuchman. Specifically, while Mr. Tuchman was in possession of the signed declaration and other formal documents (e.g., the assignment) prior to the January 19, 2001 filing date of the Eftekhari publication, he was tasked by the client with attempting to file the present patent application electronically with the U.S. Patent and Trademark Office.

The attached Rule 131 declaration (with exhibits) explains that this application (along with one other from the same inventor) constituted a “test case” for Microsoft and the law firm of Merchant & Gould, and that Mr. Tuchman experienced great difficulty in his attempts to file

the application electronically. Indeed, in an email dated January 19, 2001 (the same date as the filing of the Eftekhari publication), Mr. Tuchman explained to a Microsoft representative that the law firm was “working out some bugs in the USPTO’s software” and anticipated filing the application within the next two weeks. (Declaration of Ido Tuchman, Exhibit C.) In reply to this email, the Microsoft representative agreed that the electronic-filing efforts should be continued, but that, if difficulties persisted, the application should be filed by the end of the month “the traditional way via express mail.” (Declaration of Ido Tuchman, Exhibit D.) Indeed, this is exactly what transpired, as explained by Mr. Tuchman in the attached declaration.

The difficulties with the PTO electronic filing system in the 2000-2001 timeframe should be well known to the Examiner or the Examiner’s supervisor. In any event, the declaration of Mr. Tuchman provides a clear explanation of the delay in filing the present application and further establishes that diligent efforts were made during this 2-week period to file the application. Indeed, when it became clear that the “software bugs” could not be immediately overcome, the application was filed in a “traditional” manner under instructions from the client. Thus, due to the clear evidence of conception (i.e., the signed declaration of the inventor), and further due to the short time period between the date of the cited reference and the date of constructive reduction to practice (12 days), as well as the evidence of the drafting patent attorney’s diligent efforts to file the application during this time period (detailed in the attached declaration), it is believed that Applicant has made the necessary showing under 37 C.F.R. 1.131 to overcome this reference.

In view of the attached Rule 131 declaration, it is apparent that the Eftekhari publication does not represent prior art to the present application. Therefore, because Eftekhari was cited in § 103(a) rejections of all the pending claims, reconsideration of these obviousness rejections is respectfully requested.

Conclusion

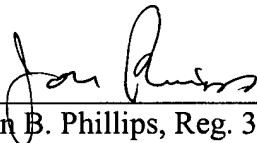
It is believed that no further fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

In light of the above remarks and amendments, it is believed that the application is now in condition for allowance and such action is respectfully requested. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

Respectfully submitted,

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